REMARKS/ARGUMENTS

Claims 1-21 are all the claims pending in this application.

Reconsideration of the subject patent application and allowance of the claims are respectfully requested in view of the following remarks.

Claims 1-5, 7-13 and 15-21 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Eggleston et al. (U.S. Patent No. 6,061,660) ("Eggleston"). Applicant respectfully traverses this rejection.

Applicable case law holds that in order to anticipate a claim, a single prior art reference must disclose each and every feature of the claim.[1] Applicant submits that Eggleston fails to disclose all features of independent claims 1, 8, 17 and 19.

Independent claim 1 recites, inter alia, "maintaining an encumbrance database that describes types of awards that cannot be redeemed at one or more suppliers." Independent claim 17 has a similar limitation. Eggleston does not disclose, teach or suggest this limitation.

The Patent Office asserts that the above limitation is disclosed at column 20, lines 9-16; column 35, line 50-column 36, line 20; column 41, lines 5-10; and column 43, lines 22-40. However, this assertion is without merit. The text at column 20, lines 9-16 simply sets forth the "prize selection require[ment]s." For example, a sponsor enters data, such as "the number of prizes, the frequency of winning, relative prize weighting (e.g., grand prize, second prize, etc.)."[2] A prize is selected based on an algorithm that depends on the selected prize frequency.[3] There is no disclosure in the cited text of a sponsor entering data "that describes types of awards that cannot be redeemed at one or more suppliers." Accordingly, Eggleston does not disclose

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1 See Gechter v. Davidson, 116 F.3d. 1454, 1457 (Fed. Cir. 1997).

2 Col. 20, lines 11-13.

3 Col. 20, lines 13-15.

"maintaining an encumbrance database that describes types of awards that cannot be redeemed at one or more suppliers."

The text at column 35, line 50-column 36, line 20 sets forth "eligibility requirements." "[I]ncentive program rules [] define eligibility for participation in an [incentive] program."[4] For example, a sponsor can exclude under aged children from its program by entering a certain age range (e.g., defining eligibility rules).[5] Further, a file is created upon the completion of a new incentive program, which includes graphical images, eligibility rules, a verification algorithm, a completion algorithm, and an appearance algorithm.[6] There is absolutely no disclosure in this cited text of "maintaining an encumbrance database that describes types of awards that cannot be redeemed at one or more suppliers."

The text at column 41, lines 5-10 describes items stored in an award database. These items include 1) a method of fulfillment by a third party or the like, 2) identification numbers of an item, 3) a description of the item, and 4) a number of available items. Again, there is no teaching or suggestion of "maintaining an encumbrance database that describes types of awards that cannot be redeemed at one or more suppliers" in the cited text.

Finally, the text at column 43, lines 22-40 describes how a consumer can redeem his/her prize. For example, a consumer can pick up the award unit from a location near the consumer's home. If a prize is not available at the remote location, the consumer can substitute his/her prize for a comparable one. Similar to the above cited text, there is absolutely no disclosure of "maintaining an encumbrance database that describes types of awards that cannot be redeemed at one or more suppliers."

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4 Col. 35, lines 49-51.

5 Col. 35, lines 51-58.

6 Col. 36, lines 2-13.

In view thereof, Eggleston does not satisfy the limitation of "maintaining an encumbrance database that describes types of awards that cannot be redeemed at one or more suppliers."

Claim 1 further recites, inter alia, "receiving a request to redeem an amount of the earned awards at a chosen supplier." Claims 8, 17 and 19 have a similar limitation. Eggleston does not disclose, teach or suggest this limitation.

The Patent Office contends that the above limitation is disclosed at column 43, lines 23-40. As described in the cited text, the consumer is instructed to go to a store to pick up an award unit.[7] The consumer does not "receiv[e] a request to redeem an amount of the earned awards at a chosen supplier," as the consumer would be the requestor (e.g., one who requests). Moreover, the system does not receive a request to redeem because after the consumer wins, he/she is instructed to go to a location near his/her home. There is no disclosure in the cited text that the consumer sends a request to redeem his/her award points. Thus, Eggleston does not satisfy this limitation.

Claim 1 recites further, inter alia, "determining allowed awards that can be redeemed with the chosen supplier." Claims 8, 17 and 19 have a similar limitation. Eggleston does not disclose, teach or suggest this limitation.

The Patent Office relies on the text at column 43, lines 22-40 and column 44, lines 1-40 of Eggleston. For reasons discussed above, Eggleston does not disclose a determination of allowed awards at column 43, lines 22-40. Further, Eggleston does not disclose a determination of allowed points at column 44, lines 1-40. This section of Eggleston simply describes a data entry made in a winner's file, and item availability. The entry in the file does not relate to allowed points. In fact, the entry in the file is the identification of a prize, which a consumer can pick up at a remote location. The only

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[7] Col. 43, lines 25-28.

determination made in Eggleston is when the retailer determines whether or not a prize is in its store. There is no "determining [of] allowed awards that can be redeemed with the chosen supplier." Thus, this limitation is not met.

Claim 1 also recites, inter alia, "determining encumbrance levels of the allowed awards based on the types of allowed awards and the data in the encumbrance database." Claim 17 has a similar limitation. Eggleston does not disclose, teach or suggest this limitation.

The Patent Office once again relies on the text at column 20, lines 9-16; column 21, lines 45-55; column 35, line 49-column 36, line 20; and column 43, lines 22-40. As discussed above, Eggleston fails to disclose "maintaining an encumbrance database" at the cited text. Correspondingly, Eggleston does not disclose "determining encumbrance levels" at the cited text for similar reasons.

Claim 1 recites further, inter alia, "determining which of the allowed awards to redeem based on the encumbrance levels." Claim 17 has a similar limitation. Eggleston does not disclose, teach or suggest this limitation.

As discussed above, Eggleston does not determine encumbrance levels, and thus, cannot teach or suggest this limitation.

With respect to claims 8 and 19, Eggleston does not disclose "award transaction information that describes awards earned by a consumer and including, for each earned award, an expiration date and an earning date." The Patent Office has not identified a teaching of at least "an expiration data and an earning date" in the Eggleston reference.

Since Eggleston fails to teach each and every limitation of claims 1, 8, 17 and 19, Eggleston cannot anticipate these claims. Thus, the rejection of claims 1, 8, 17 and 19 should be withdrawn.

Dependent claims 2-7, 9-16, 18, 20 and 21 depend directly or indirectly on at least one of independent claims 1, 8, 17 and 19, and are submitted to be patentable

and distinguishable over Eggleston for at least the same reasons discussed above with respect to claims 1, 8, 17 and 19.

Claims 6 and 14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Eggleston. Applicant respectfully traverses this rejection.

Applicable case law holds that in order for prior art to render a claim obvious, the prior art must suggest all of the claimed features to a person of ordinary skill in the art.[8] Applicant submits that Eggleston fails to teach or suggest all features of dependent claims 6 and 14.

In the Office Action, the Patent Office states that:

> [I]t would have been obvious to a person of ordinary skill in the art ... to know that if the Eggleston's award system indicates expiration dates after which the prize would not be redeemed, the Eggleston's award system would also indicate black-out dates where prizes would also not be redeemed. This feature would be a business decision that would not patentably distinguish the claimed invention from the prior art.

The Examiner has not met his burden for establishing a prime facie case of obviousness. MPEP § 2142 makes it clear that "to support the conclusion that the claimed invention is directed to obvious subject matter, either the reference must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."[9] There is no motivation in the Eggleston reference to arrive at the claimed invention.

Eggleston does not disclose "expiration dates after which the prize would not be redeemed." Thus, it would not have been obvious to modify Eggleston to include black-out dates. Moreover, the Patent Office's purported rationale is merely a broad conclusory statement (e.g., this would be a business decision that would not patentably

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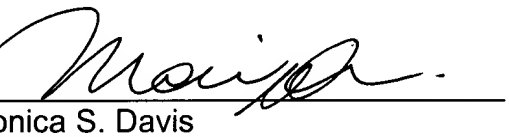
[8] In re Vaeck, 947 F.2d. 488, 493, 20 USPQ2d. 1438 (Fed. Cir. 1991).

[9] Ex parte Clapp, 1985 Pat. App. LEXIS 34, 227 USPQ (BNA) 972, 973 (Pat. App. 1985).

distinguish the claimed invention from the prior art). A broad conclusory statement is not evidence.[10] Without evidence of a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability, the essence of hindsight.[11] Clearly, Eggleston does not suggest the claimed invention, and the proposed modification is no more than a hindsight reliance on the teachings in the present application of the advantages of the present invention. Hence, the rejection of claims 6 and 14 should be withdrawn.

Applicant submits that the present application is now in condition for allowance. Reconsideration and favorable action are earnestly requested.

Respectfully submitted,

By 

Monica S. Davis
Attorney for Applicants
Registration No. 44,492
ROTHWELL, FIGG, ERNST & MANBECK, p.c.
Suite 800, 1425 K Street, N.W.
Washington, D.C. 20005
Telephone: (202) 783-6040
Facsimile: (202) 783-6031

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[10] See McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d (BNA) 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ (BNA) 209, 217 (CCPA 1977).

[11] See, e.g., In re Rouffet, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998).